

REMARKS

The Examiner has restricted the claims of the invention into 29 groups as set forth on pages 2-3 of the Office Action, plus an additional 3 groups as set forth on page 4.

Applicants provisionally elect, with traverse, **Group II (Claim 25)**, directed to a cysteine variant of IL-11, wherein a cysteine residue is inserted following the last amino acid of IL-11. Applicants further elect, with traverse, **Group (A) a cysteine-reactive moiety**.

Applicants first traverse the restriction among Groups I-XIX, which is a restriction on the basis of a specific region for a cysteine substitution, Applicants submit that the situation at hand is described in MPEP 803.02 regarding restriction practice with respect to Markush claims. As set forth in MPEP 803.02, "unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility." In the present application, all of the members of Claims 24, 25 and the Markush group of Claim 26 and related claims share the common utility of being useful for the same general utilities as the wild-type IL-11 parent (represented by SEQ ID NO:17). In addition, it is submitted that the members of the Markush group also share a substantial structural feature that is essential to that utility, which includes having a structure that is sufficiently similar to the wild-type sequence of SEQ ID NO:17 that the variants have IL-11 biological activity. In addition, the members all share the common structural feature of being cysteine variants, which provides the additional common utility of being readily modified to increase stability and half-life of the protein. In this case, as described in MPEP 803.02, the individual claims 24 and 25 and Markush Claim 26 was used because there is no appropriate or true generic language. Applicants submit that the provisions specified in MPEP 803.02 should apply here and that the restriction between variants is not appropriate, even if the groups are independent and distinct, as the groups are linked by the common utility and structural characteristic, and because recitation by enumeration was the only reasonable way to claim this invention. At most, it appears that the Examiner should have required an election of *species* in this case, and not made a *restriction* requirement. Based on the Restriction Requirement in the original application (U.S. Application No. 09/462,941), Applicants have already separated the originally claimed invention on the basis of specific proteins as well as at the level of substitutions versus insertions. Applicants submit that to now ask that the invention be *further* divided as to regions of the protein for each and every protein presented in the application significantly increases the prosecution expense to the Applicants and to the Patent Office in an unreasonable manner, given the

arguments presented above. In the present case, the subject matter of these Groups cited by the Examiner is sufficiently small and is so closely related as to be capable of examination together.

With respect to the further restriction of Groups A-C, Applicants initially submit that this restriction has not been explained in the Office Action. Applicants respectfully submit that the groups are also overlapping such that the restriction requirement does not make sense. For example, modification with polyethylene glycol is one example of a modification with a cysteine-reactive moiety (*i.e.*, polyethylene glycol is a cysteine-reactive moiety). Therefore, a thorough search for Group A would be sufficient to search Groups B and C. Furthermore, these claims depend from the elected independent claim, and therefore, a thorough search for the subject matter of the claims of Groups I-XIX is sufficient to examine Claims 44-46. Applicants submit that it is unnecessary and unreasonable to ask that the invention be divided in this additional manner.

In view of the foregoing discussion, Applicants respectfully request that the Examiner withdraw the restriction among Groups I-XIX and among Groups A-C.

Respectfully submitted,

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